REMARKS

Claims 1-20 are now pending in the application. Claims 11 and 20 have been amended without introduction of new matter. Favorable reconsideration is respectfully requested in view of the above amendments and the following remarks.

Claims 11 and 20 stand rejected under 35 USC §112, second paragraph as allegedly being indefinite. In particular, the Office objected that in each of claims 11 and 20, the initial recitation of the phrase "the computing device" lacks antecedent basis. In response, each of claims 11 and 20 has been amended to now recite "a computing device" the first time this term is introduced. Consequently, these claims are now believed to define embodiments with sufficient particularity and distinctness to satisfy the requirements of the statute. It is therefore respectfully requested that the rejection of claims 11 and 20 under 35 USC §112 be withdrawn.

Claims 1-20 stand rejected under 35 USC §103(a) as allegedly being unpatentable over Ross et al., U.S. Publication Number 2004/0058651 A1 (hereinafter Ross) in view of Phillipi et al., U.S. Publication Number 2004/0044761 A1 (hereinafter Phillipi). This rejection is respectfully traversed.

To facilitate an appreciation of why the variously claimed embodiments are patentably distinguishable over the prior art of record, it is important to understand that a fundamental purpose of the variously claimed embodiments is to provide users of communications equipment with an indication of the level of network performance that they are likely to experience. As explained in the Background section, signal strength indicators have been used for this purpose in conventional systems. However, signal strength alone is not necessarily a good indicator of expected network performance because it fails to take into account factors such as network loading conditions.

The various embodiments claimed in this application address this problem by providing a mechanism in which the network is capable of deriving a better estimate of data throughput that will be experienced by a device by using not only a parameter supplied by that device but also network service measurement data. In claim 1, this is defined as "a server in communication with the service measurement database, wherein the server estimates a data throughput for a device that is in communication with the network *based on the network service measurement data and a parameter received from the device that is in communication with the network.*" (Emphasis added.)

In independent method claim 11, this is defined as "receiving a first parameter from a communications device that is in communication with a computing device; receiving a second parameter from a service measurement database; calculating the relative network throughput *based on the first and second parameters.*" (Emphasis added.)

In independent apparatus claim 20, this is defined as "means for receiving a first parameter from a communications device that is in communication with a computing device; means for receiving a second parameter from a service measurement database; means for calculating a network throughput *based on the first and second parameters.*" (Emphasis added.)

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office has failed to make out a *prima facie* case of obviousness for a number of reasons. To begin with, neither of the Ross and Phillipi documents relied on by the Office discloses determining a network throughput using both a parameter received from the device and also a parameter from a service measurement database.

In addition, neither of the Ross and Phillip documents discloses a server calculating network throughput for a device, and then communicating this information to the device.

The Office acknowledges that Ross fails to teach a server estimating a data throughput for a device. What is overlooked in the Office Action is that Ross expressly teaches data throughput being determined in the device itself. (See Ross at page 3, paragraph 22: "the system 10 can utilize the existing wireless device diagnostic interface and any resident tools that are manufactured with the device, such as data throughput, signal strength ....") The server in Ross is unconcerned with generating a throughput of the device because its purpose is to generate optimization command data that is transmitted back to the wireless

device to cause the wireless device to modify its functionality. See, for example, Ross at page 4, paragraph 32.

It must be recalled that "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)," MPEP §2143.01 at page 2100-132 (Rev. 2, May 2004). Clearly, then, it is improper for the Office to allege that it would have been obvious to modify the server of Ross to calculate device data throughput because such modification would change the principle of operation taught in Ross, whereby the wireless device determines its own data throughput and communicates this information to the server, and not the other way around.

Moreover, it is evident that the Ross document fails to provide any motivation for providing the server with the capability of determining data throughput because Ross solves this problem by providing the capability in the wireless device itself.

The Phillipi document fails to make up for the deficiencies of Ross. The Office relies on Phillipi at paragraph 53 as allegedly disclosing a system and method for broadband network optimization, comprising calculating network throughput based on first and second parameters and communicating the network throughput to a communications device.

Applicant respectfully disagrees with this interpretation of Phillipi. To begin with, Phillipi discloses that throughput is determined based only on the transmission of test data by the network and the subsequent measurement of throughput experienced by that test data. (See, e.g., Phillipi at figure 5, block 86 and supporting text in paragraph 53.) Nowhere does Phillipi disclose that the server takes into account a parameter supplied by a communications device. Thus, Phillipi fails to disclose "estimat[ing] a data throughput for a device that is in communication with the network *based on the network service measurement data and a parameter received from the device* that is in communication with the network" as variously defined by Applicant's claims.

Furthermore, Phillipi does not disclose communicating the network throughput to a communications device. Instead, the system of Phillipi compares the throughput experienced by different test data in order to determine an optimum set of values of transmission variables which may then be provided to one of the network devices in order to achieve optimum

network performance. (See, e.g., Phillipi at figure 5, blocks 88 and 90, and supporting text in paragraph 53.)

Applicant also can find no meaningful basis for the Office's assertion that "One of ordinary skill in the art further recognizes that, the network optimization data calculated by server 16 as taught by Ross, broadly reads on a data throughput of the system." In Applicant's application, the term "data throughput" is used in its typical sense to mean a measure of how much data can be communicated in a given period of time. That this is how one of ordinary skill in the art would construe this term is evident in the prior art cited here: both Ross and Phillipi use the term "data throughput" in this way. Moreover, and contrary to the Office's assertion, Ross does not use the term "network optimization data". Rather, Ross refers to "optimization command data" which is unambiguously described as data transmitted back to a wireless device to cause that device to modify its functionality. (See, e.g., Ross at paragraph 32.) Thus, the Office's assertion that a command that causes a device to modify its functions is the same as a data value indicating a present level of functioning appears not to be grounded in the actual meanings of these terms.

It should be apparent from the above discussion that even if one were to combine the teachings of Ross with Phillipi, that combination would still fail to include:

- estimating a data throughput for a device based on network service measurement data and a parameter received from the device (defined in each of independent claims 1, 11, and 20); and
- communicating the network throughput to the device (defined in each of independent claims 11 and 20).

For at least the foregoing reasons, the independent claims 1, 11, and 20, as well as the dependent claims 2-10 and 12-19, are believed to be patentably distinguishable over the Ross and Phillipi documents regardless of whether these documents are considered individually or in combination. Accordingly, it is respectfully requested that the rejection of claims 1-20 under 35 USC §103(a) be withdrawn.

The application is believed to be in condition for allowance. Prompt notice of same is respectfully requested.

Respectfully submitted,
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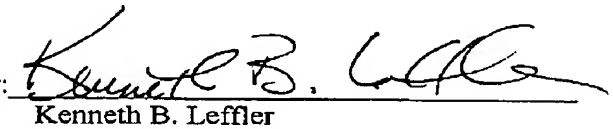
By: 
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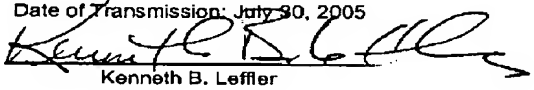
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